

REMARKS

This responds to the Office Action dated March 14, 2008.

Claims 1 and 17 are amended and no claims are canceled or added; as a result, claims 1-13 and 16-24 remain pending in this application.

§101 Rejection of the Claims

Claims 1-13 and 16-24 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Applicant has amended independent claim 1 to clarify that the modules are present and operable on a server machine. This amendment is supported by the application as filed, such as on page 2, lines 20-22 and page 5, lines 5-8 amongst other locations. Applicant respectfully submits that this amendment clarifies that the claims are directed to a system including a server machine including the claimed modules. Claims 2-23 and 16-24 depend, directly or indirectly, from amended independent claim 1 and the amendment equally applies to these dependent claims as well. Entry of this amendment and withdrawal of the 35 U.S.C. § 101 rejection is respectfully requested.

§103 Rejection of the Claims

Claims 1-13, 16-21 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson et al. (U.S. Patent No. 6,549,894; hereinafter “Simpson”) in view of Snyder (U.S. Patent Application Publication No. 2002/0111953; hereinafter “Snyder”).

Applicant has amended independent claim 1 to incorporate a portion of claim 17, which is also amended. The amendment to claim 1 specifies that that messaging module provides “messaging to users of the system as a function of user roles in managed tasks and matters.” As this language was taken from currently rejected claim 17, the rejection of claim 17 becomes applicable to amended independent claim 1.

In rejecting claim 17, the Office Action admits that Snyder is deficient and asserts:

“...Snyder discloses ‘wherein the messaging module is further operable to send electronic mail (e-mail) to users, the e-mail comprising information relating to the user’s role in managed tasks and matters’ as (Snyder Paragraph [0065].”

However, Applicant has reviewed paragraph [0065] and there is no mention of user roles or messaging in any way related to user roles. Snyder paragraph [0065] recites:

[0065] The documents stored in or referred to by a case data unit may include a variety of documents of different document types. Specific examples of document types include an invention disclosure, a filed patent application, patent drawings, old versions of patent applications and drawings, other patent papers (e.g., other documents filed in the patent office including Responses to Office Actions, Information Disclosure Statements, Petitions, etc.), forms, image files (e.g., locked documents of .pdf or a similar type of image file format corresponding to a granted patent (if a patent was granted for the case) as well as electronic scanned copies of any office actions received, responses filed in the patent office, filing receipts, etc. received during prosecution of the patent application, notes (e.g., practitioner notes, inventor notes, notes from other interested parties regarding the importance of the patent to a companies business, products or competitors business or products, etc.), mail (e.g., email messages or alerts), and prior art references among others. It is to be understood that this list is for illustrative purposes only and various embodiments of the invention can include more or fewer document types and information as appropriate.

There is simply no mention of messaging of any type or messaging based on user roles. The subsequent paragraphs of Snyder discuss messaging, but only in the context of users and not of user roles. Thus, Applicant respectfully submits that due to the admitted deficiency of Simpson and Snyder failing to provide an adequate teaching or suggestion of messaging as a function of user roles, the combination fails to make a *prima facie* showing of obviousness with regard to amended independent claim 1.

Applicant also notes that Snyder by itself is not a prior art reference as the filing date is November 21, 2001, which is after the June 1, 2001 filing date of the present application.

Snyder claims priority to two provisional applications; however, only one of these applications is prior to the filing date of the present application. That application is provisional application 60/253,360 filed November 27, 2000. Thus, any assertions of Snyder as prior art must have been supported and enabled by the disclosure included within the '360 provisional patent application. Applicant has also reviewed the '360 provisional patent application and has been unable to locate any teaching or suggestion of "messaging to users of the system as a function of user roles in managed tasks and matters" as in amended independent claim 1.

Thus, Applicant respectfully submits that the combination of Simpson and Snyder fails to render amended independent claim 1 obvious. Consideration of the amendment to independent claim 1 in view of the above arguments and allowance of the claim is respectfully requested.

Claims 2-13, 16-21, and 24 depend, directly or indirectly, from patentable independent claim 1 and are also patentable for at least the same reasons.

Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejections of claims 1-13, 16-21, and 24 and allowance of the claims.

Claims 22-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson in view of Snyder as applied to claims 1-13, 16-21 and 24 above, further in view of Lee et al. (U.S. Patent No. 6,839,707; hereinafter “Lee”). Lee is presented to show the additional elements of claims 22 and 23. However, Lee fails to cure the deficiencies with regard to amended independent claim 1 and dependent claims 18 and 21 from which claims 22 and 23 directly and indirectly depend. Thus, because the claims from which claims 22 and 23 depend are patentable as discussed above, claims 22 and 23 are also patentable. Withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claims 22 and 23 is respectfully requested.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner’s personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official

Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6938 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date June 08

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 16 day of June 2008.

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Name

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